

REMARKS

Applicants have amended claims 31, and have cancelled claims 1-18 and 32-40, during prosecution of this patent application. Applicants are not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner objected to the specification.

The Examiner rejected claims 19-20, 22-27, 30, 31, 41-44 and 47-49 under 35 U.S.C. § 102(b) as allegedly being anticipated by Carro (US 2001/0056439, Publication Date: December 27, 2001).

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro in view of Duwaer (US 5,402,151, issued 03/28/1995).

The Examiner rejected claims 28, 29, 45 and 46 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro in view of Dymetman et al. (US 6,330,976).

Applicant respectfully traverses the specification objection, the § 102 rejections, and the § 103 rejections with the following arguments.

Specification Objection

The Examiner objected to the specification.

The Examiner argues: “The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code for example at page 4, lines 6-19.

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code.”

In response, Applicant has deleted lines 4-19 on page 4 of the specification.

Accordingly, Applicant respectfully requests that the objection to the specification be withdrawn.

35 U.S.C. § 102(b): Claims 19-20, 22-27, 30, 31, 41-44 and 47-49

The Examiner rejected claims 19-20, 22-27, 30, 31, 41-44 and 47-49 under 35 U.S.C. § 102(b) as allegedly being anticipated by Carro (US 2001/0056439, Publication Date: December 27, 2001).

Applicant respectfully contends that Carro does not anticipate claim 19, because Carro does not teach each and every feature of claim 19. For example, Carro does not teach the feature: “creating a record in a selections table stored in a user device, said creating the record comprising entering into the record: a document number that identifies both the physical document and an electronic document that is an electronic copy of the physical document, a page number that identifies a page of the physical document and a corresponding page of the electronic document, and a network address of a server that stores the electronic document”.

The Examiner argues: “Carro teaches ... creating a record in a selections table stored in a user device, said creating the record comprising entering into the record: a document number that identifies both the physical document and an electronic document that is an electronic copy of the physical document, a page number that identifies a page of the physical document and a corresponding page of the electronic document, and a network address of a server that stores the electronic document (*See [0068] through [0075] 9 the user assigns a reference number (identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document and other relevant information related to the document such as title, author, ISBN (International Standard Book Number), or date. The hyperlink table may be stored within the*

user workstation or may be stored in an external memory accessible from the user workstation ... enters the page number where the item is marked in the hyperlink table of the document (e.g., 16), associates this item with a destination address within the communication network, this destination address identifying a server connected to the communication network and the information and/or services within this server the user wants to access)".

In response, Applicant respectfully contends that Carro does not teach "an electronic document that is an electronic copy of the physical document" as claimed and therefore does not teach the preceding feature of claim 19. Carro's invention relates only to a physical document and not to "an electronic document that is an electronic copy of the physical document". For example, see Carro, Par. [0054] ("The present invention discloses a system and method for selecting and accessing multimedia information and/or services located on one or a plurality of servers connected to a communication network simply by touching with a finger items marked on ***a physical document*** or on any other physical surface" (emphasis added)).

With respect to the claimed feature of "entering into the record: a document number that identifies both the physical document and an electronic document that is an electronic copy of the physical document", the Examiner relies on Carro, Par. [0071} which recites: "As shown in FIG. 4, for each document he receives, the user assigns a reference number (identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document".

In response, Applicant asserts that the document in Carro, FIG. 4 referred to in Carro, Par. [0071} is a physical document and not an electronic document that is an electronic copy of a

physical document, as evidenced by Carro, Par. [0069} which recites: “*a hand written or printed document* (like the document shown in FIG. 4 entitled "Early British Kingdoms")” (emphasis added).

With respect to the claimed feature of “entering into the record: ... a network address of a server that stores the electronic document”, the Examiner’s reference to “this destination address identifying a server connected to the communication network and the information and/or services within this server the user wants to access” does not address “a network address of a server that stores the electronic document” is thus irrelevant to the preceding feature of claim 19.

Applicant asserts that the relevance of the server is explained in Carro, Par [0036] which recites: “said hyperlink table comprising for each marked item of each page of the document the identification on a server of *the information or service associated with the selected marked item*” (emphasis added). Thus, Carro teaches that the server comprises an identification of information or a service associated with the selected marked item on the physical document, but does not teach that the server stores the electronic document that is an electronic copy of the physical document and therefore does not teach “entering into the record: ... a network address of a server that stores the electronic document” as claimed.

Based on the preceding arguments, Applicant respectfully maintains that Carro does not anticipate claim 19, and that claim 19 is in condition for allowance. Since claims 20, 22-27, 30, 31, 41-44 and 47-49 depend from claim 19, Applicant contends that claims 20, 22-27, 30, 31, 41-44 and 47-49 are likewise in condition for allowance.

In addition with respect to claim 20, Carro does not teach the feature: “wherein the identification identifies the coordinates of the vertices of a polygon drawn around the selected region”.

The Examiner argues: “As to Claim 20: Carro teaches the identification identifies the coordinates of the vertices of a polygon drawn around the selected region (*See [0093] through [0098] - Determining the Position on the Page ... The touch foil sends a signal to the user workstation to identify to selected marked item. This signal indicates the position on the page of the point that has been pressed by the user on the touch foil. The generated signal is generally proportional to the coordinates (X/Y) of the point pressed.*)” (emphasis added).

In response, Applicants asserts that “the coordinates (X/Y) of the point pressed” identifies a single point, and thus not “the vertices of a polygon drawn around the selected region” as claimed.

Therefore, Carro does not anticipate claim 20.

In addition with respect to claim 22, Carro does not teach the feature: “wherein the electronic document is an exact replica of the physical document”.

The Examiner argues: “As to Claim 22: Carro teaches the electronic document is an exact replica of the physical document (*See [0057] – [0059] - a hard-copy document 101 (e.g., a book) ... The physical document 101 can be of any kind, for example, a newspaper, a geographic map, a novel book, a text book, a technical book, a commercial catalog or even any other type of engraved or printed surface ... the document can be paper, plastic, wood or other material*)”.

In response, Applicants asserts that the preceding argument by the Examiner relates only to a physical document and not to an electronic document, and does not demonstrate a teaching by Carro of “the electronic document is an exact replica of the physical document” as claimed

Therefore, Carro does not anticipate claim 22.

In addition with respect to claim 24, Carro does not teach the feature: “sending selected data in the record of the selections table to a user workstation, wherein the selected data comprises the document number, the page number, and the network address”.

As explained *supra* in conjunction with claim 19, Carro does not teach “an electronic document that is an electronic copy of the physical document” and therefore does not teach that the selected data comprises the document number that identifies both the physical document and an electronic document that is an electronic copy of the physical document, the page number that identifies a page of the physical document and a corresponding page of the electronic document, and a network address of a server that stores the electronic document.

Therefore, Carro does not anticipate claim 24.

In addition with respect to claim 26, Carro does not teach the feature: “wherein the request does not include any text or graphics comprised by the physical document other than the document number and the page number”.

The Examiner argues: “As to Claim 26: Carro teaches the request does not include any text or graphics comprised by the physical document other than the document number and the page number (*See [0071]* → *each document he receives, the user assigns a reference number*

(identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document and other relevant information related to the document such as title, author, ISBN (International Standard Book Number).)”.

In response, Applicants asserts that the preceding argument by the Examiner admits that the request includes other text (title, author) than the document number and the page number.

Therefore, Carro does not anticipate claim 26.

In addition with respect to claim 27, Carro does not teach the feature: “wherein the method further comprises transmitting, to a destination document, a copy of a region on the received page of the electronic document corresponding to the selected region on the physical document”.

The Examiner argues: “As to Claim 27: Carro teaches transmitting, to a destination document, a copy of a region on the received page of the electronic document corresponding to the selected region on the physical document *(See [0054] through [0058].)*”.

In response, Applicants reiterates, as was explained *supra* in conjunction with claim 19, that Carro does not teach “an electronic document that is an electronic copy of the physical document” and therefore cannot teach the preceding feature of claim 27 which refers to a copy of a region on the received page of *the electronic document* corresponding to the selected region on the physical document. The Examiner’s citation of Carro, Pars. [0054] - [0058] does not mention anything about an electronic document that is an electronic copy of the physical

document.

Therefore, Carro does not anticipate claim 27.

In addition with respect to claim 26, Carro does not teach the feature: “wherein the request does not include any text or graphics comprised by the physical document other than the document number and the page number”.

The Examiner argues: “As to Claim 26: Carro teaches the request does not include any text or graphics comprised by the physical document other than the document number and the page number (*See [0071] → each document he receives, the user assigns a reference number (identifier) to this document (e.g., 387) for identifying said document, writes this reference number (identifier) on the document, and creates a hyperlink table associated with the document and accessible from the workstation, said hyperlink table comprising the reference number of the document and other relevant information related to the document such as title, author, ISBN (International Standard Book Number).*)”.

In response, Applicants asserts that the preceding argument by the Examiner admits that the request includes other text (title, author) than the document number and the page number.

Therefore, Carro does not anticipate claim 26.

In addition with respect to claim 27, Carro does not teach the feature: “wherein the method further comprises transmitting, to a destination document, a copy of a region on the received page of the electronic document corresponding to the selected region on the physical document”.

The Examiner argues: “As to Claim 27: Carro teaches transmitting, to a destination document, a copy of a region on the received page of the electronic document corresponding to the selected region on the physical document (*See [0054] through [0058].*)”.

In response, Applicants reiterates, as was explained *supra* in conjunction with claim 19, that Carro does not teach “an electronic document that is an electronic copy of the physical document” and therefore cannot teach the preceding feature of claim 27 which refers to a copy of a region on the received page of *the electronic document* corresponding to the selected region on the physical document. The Examiner’s citation of Carro, Pars. [0054] - [0058] does not mention anything about an electronic document that is an electronic copy of the physical document.

Therefore, Carro does not anticipate claim 27.

In addition with respect to claim 31, Carro does not teach the feature: “a computer readable storage medium, said storage medium storing instructions for performing the method of claim 19 when said instructions are executed on the user device”.

The Examiner does not present any argument allegedly supporting that Carro teaches the preceding feature of claim 31.

Therefore, Carro does not anticipate claim 31.

In addition with respect to claim 41, Carro does not teach the feature:

“receiving, by a user workstation from the user device, selected data from the record of

the selections table stored in the user device, wherein the selected data comprises the document number that identifies both the physical document and the electronic document that is an electronic copy of the physical document, the page number that identifies the page of the physical document and the corresponding page of the electronic document, and the network address of the server that stores the electronic document;

sending, from the user workstation across a network to the server at the network address, a request for the page of the electronic document, wherein the request specifies the document number and the page number; and

receiving, by the user workstation from the server, the requested page of the electronic document”.

The Examiner argues that Carro, Pars. [0068] - [0075] teaches the preceding feature of claim 41.

In response, Applicant does not discuss anything about “an electronic document that is an electronic copy of the physical document” and therefore cannot teach the preceding feature of claim 41 which relates specifically to a page of the electronic document.

Therefore, Carro does not anticipate claim 41.

In addition with respect to claims 42-44, 47 and 48, the Examiner argues: “As to Claims 42- 44, 47 and 48: Refer to the discussion of Claims 25- 27, 30 and 22 above, respective, for rejections.”

In response, Applicant refers to Applicant’s arguments *supra* for claims 25- 27, 30 and 22.

35 U.S.C. § 103(a): Claim 21

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro in view of Duwaer (US 5,402,151, issued 03/28/1995).

Since claim 21 depends from claim 19, which Applicants have argued *supra* to not be anticipated by Carro under 35 U.S.C. §102(b), Applicant maintains that claim 21 is not unpatentable over Carro in view of Dymetman under 35 U.S.C. §103(a).

35 U.S.C. § 103(a): Claims 28, 29, 45 and 46

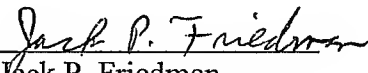
The Examiner rejected claims 28, 29, 45 and 46 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Carro in view of Dymetman et al. (US 6,330,976).

Since claims 28, 29, 45 and 46 depend from claim 19, which Applicants have argued *supra* to not be anticipated by Carro under 35 U.S.C. §102(b), Applicant maintains that claims 28, 29, 45 and 46 are not unpatentable over Carro in view of Dymetman under 35 U.S.C. §103(a).

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

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